

REMARKS

After entry of the above amendments, the claims pending in the subject application are 22, 33-42, and 44-57. Reconsideration of this application based on the Amendments and Remarks presented herein is respectfully requested.

The shortened statutory period for response expired on April 29, 2003. Accordingly, a Petition for a One-Month Extension of Time is attached hereto. The Director - U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account 23-3425 the necessary extension fees identified in the attached Petition and any other fees necessary for entry of this amendment.

Claim 22 has been rewritten in independent form to incorporate the subject matter of claim 1 from which it depended. With the cancellation of claim 1, the rewriting of claim 22 in independent form does not result in a number of independent claims greater than previously paid for. With the cancellation of claims 1-21 and 23-32, the addition of claims 45-57 does not result in a total number of claims greater than previously paid for. In the event that Applicants have overlooked the need for a claim fee, the Director - U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account 23-3425 the claim fees necessary for entry of this amendment.

On the Notice of References Cited and in Paragraph 17 of the Office Action, U.S. Patent Application Publication 2003/0004081 to Ellis et al. was cited as being considered pertinent to applicant's disclosure. U.S. Patent Application Publication 2003/0004081 is a publication of the present application. An application cannot be prior art against itself.

RESTRICTION REQUIREMENT

Restriction was required to one of the following groups under 35 U.S.C. §121:

Group	Claims	Description
I	1-21 and 23-32	Composition
II	22 and 33-44	Method of Removing Scale

Applicants elect Group II, claims 22 and 33-44, without traverse.

35 U.S.C. §112 REJECTIONS

Claim 43 was rejected under 35 U.S.C. §112, first paragraph. This rejection is rendered moot with the cancellation of claim 43.

Claims 33-43 were rejected under 35 U.S.C. §112, second paragraph. Claim 33 did not positively recite removing scale from the substrate surface. Claim 33 has been amended to recite the inherent result of removing scale. It is respectfully submitted that claims 33-43 are not indefinite.

Claim 35 used the term "for from". Claim 35 has been amended to delete the extraneous "for". It is respectfully submitted that claim 35 is not indefinite.

Claim 45 [42] did not recite whether the passivating is done before or after the rinsing or the circulating step. Since there is no claim 45, it is assumed that claim 42 was the intended claim because claim 42 includes the passivating step. Claim 42 has been amended to recite that the passivating is done after the rinsing step. It is respectfully submitted that claim 42 is not indefinite.

35 U.S.C. §102 REJECTIONS

Claims 22, 33-35, and 41-42 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. RE30,796 to Lesinski.

Independent claims 22 and 33 have been amended to include the following two provisos,

- i. the composition consists of a) at least one of citric acid and a derivative of citric acid that can be converted to citric acid by hydrolysis, b) the basic agent, and c) optionally, water; or
- ii. the chelating agent is at least one of adipic acid, malonic acid, succinic acid, 1,2-benzenedicarboxylic acid, 1,3-benzenedicarboxylic acid, 1,4-benzenedicarboxylic acid, heptanedioic acid, diglycolic acid, itaconic acid, malic acid, fumaric acid,

glutamic acid, tartaric acid, ethyleneglycol-bis(β -aminoethyl ether)-N,N-tetraacetic acid, and a derivative of any of the preceding acids that can be converted to the acid by hydrolysis.

Lesinski '796 does not disclose or suggest the above acids/derivative of the acids in combination with the basic agent as is claimed. Therefore, it is respectfully submitted that claims 22, 33-35, and 41-42 are not anticipated by United States Patent No. RE30,796 to Lesinski.

Claims 22, 33-35, and 44 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,762,821 to Tate.

Independent claims 22 and 33 have been amended as described above. Tate '821 does not disclose or suggest the above acids/derivative of the acids in combination with the basic agent as is claimed. Therefore, it is respectfully submitted that claims 22, 33-35, and 44 are not anticipated by United States Patent No. 5,762,821 to Tate.

Claims 22 and 33 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 3,033,214 to Bersworth et al.

Independent claims 22 and 33 have been amended as described above. Bersworth '214 does not disclose or suggest the above acids/derivative of the acids in combination with the basic agent as is claimed. Therefore, it is respectfully submitted that claims 22 and 33 are not anticipated by United States Patent No. 3,033,214 to Bersworth et al.

35 U.S.C. §103 REJECTIONS

Claims 36-37 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. RE30,796 to Lesinski.

Claims 36-37 and 40 depend from independent claim 33. Because claim 33 is not anticipated by and is patentable over the cited art from above, claims that depend from claim 33 are therefore also not anticipated and are patentable over the cited art. Therefore, it is

respectfully submitted that claims 36-37 and 40 are patentable over United States Patent No. RE30,796 to Lesinski.

Claims 36-37 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,762,821 to Tate.

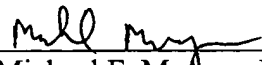
Claims 36-37 and 40 depend from independent claim 33. Because claim 33 is not anticipated by and is patentable over the cited art from above, claims that depend from claim 33 are therefore also not anticipated and are patentable over the cited art. Therefore, it is respectfully submitted that claims 36-37 and 40 are patentable over United States Patent No. 5,762,821 to Tate.

Claims 36-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 3,033,214 to Bersworth et al.

Claims 36-40 depend from independent claim 33. Because claim 33 is not anticipated by and is patentable over the cited art from above, claims that depend from claim 33 are therefore also not anticipated and are patentable over the cited art. Therefore, it is respectfully submitted that claims 36- 40 are patentable over United States Patent No. 3,033,214 to Bersworth et al.

In view of the amendments and remarks contained above, Applicants respectfully request reconsideration of the application, withdrawal of the 35 USC §102, §103, and §112 rejections, and request that a Formal Notice of Allowance be issued for claims 22, 33-42, and 44-57. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,


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